

REMARKS

In the Office action of December 22, 2008, claims 1, 2, 4-7, 9-17, 19, 20, 22-25, 27-35, 37 and 39 were rejected under 35 U.S.C. 103 (a) as being unpatentable over Dowden et al. (GB2342536A) in view of Chow et al. (US20030185203A1) and further in view of Kuwabara (US2005099997 A1).

Claim 42 was rejected under 35 U.S.C. 103 (a) as being unpatentable over Chow et al. (US20030185203A1) in view of Valloppilli et al. (US 20040137921 A1) and further in view of Kuwabara (US2005099997 A1).

In the rejections, reliance was placed on Kuwabara when it was said at page 4, last full paragraph, that in analogous art, Kuwabara teaches a communication device activates a fake ring-tone when the message is being received by a computer (see fig. 1, pars. 0040 lines 1-14, 0041 lines 1-3, 0042, lines 1-4 - Kuwabara teaches an IP phone system where an IP phone device 10 sends commands via an audio cable to a computer device 20 (i. e., gateway), which is connected to the Internet in order to reach an intended party.)

Kuwabara (US patent application publication no. US 2005/0099997) discloses an IP phone device that is connected to a PC by an audio cable. The PC is installed with an Internet telephony software. This software performs the corresponding call processing for the Internet call. While the called party's telephone number is being dialed, the IP phone generates a ringing tone that is output from an internal speaker of the handset. The ringing tone is referred to in paragraph [0041] of Kuwabara as a "fake ringing tone".

Based on the above, the examiner rejected the limitation in the independent claims of the present application that "the communication device activates a fake ring-tone when the message is being received by the gateway so that the user is made to feel that the destination telephone is being dialed in a conventional way".

The Applicants would point out that the word "fake" in both applications refers to different things. In Kuwabara, the ring tone is considered fake because it is generated internally by an IP phone when the called party is being dialed, i.e., during direct dialing of a destination telephone.

By contrast, in the present application, the ring tone is fake because it is activated when the message is being received by the gateway. The user doesn't know this, and is made to feel that the destination telephone is being dialed in a conventional way when there is no dialing of the destination

telephone. Unlike Kuwabara, in the present application, it is a gateway or server that receives the message, and not the destination telephone receiving a call. So in Kuwabara it is not actually a false ring tone but an artificially generated ring tone. In the present application, it is clearly a completely false ring tone.

Therefore, independent claims 1, 19, 37 and 42, have been amended to further recite:

“the communication device (or the messaging-enabled device in claim 37 or messaging-enabled phone in claim 42) is registered with the gateway before it is provided to the user and wherein

“the communication device activates a fake ring-tone when the message is being received by the gateway so that the user is made to feel that the destination telephone is being dialed in a conventional way; and

“wherein the communication device activates the fake ring-tone during a sequence in which the gateway hangs up on the communication device, calls back the communication device and then places the call to the destination telephone.”

Support for the amendment is provided in the paragraph of the specification at Page 14, line 16- page 15, line 11, where it is said:

In a further embodiment, the user does not necessarily send an SMS to the service provider. Instead of, or in addition to the SMS message, the message sent to the server is a normal phone call. The user may dial the destination go number via the keypad on the phone, as in conventional usage of phones, but the telephone is programmed to call the server instead of the destination number. A fake ring-tone is optionally played so that the user is made to feel that he is dialing the destination line in a conventional way, and is prevented from guessing the mechanism of this embodiment. When the server receives the incoming call from the phone, it hangs up without picking up the line so that there is no charge incurred by the user calling the server. The server then calls the user's phone. The user's phone answers the call, and transfers the destination number dialed by the user to the server (at this time, the user is still s preferably hearing the ring-tone). The number may be transferred from the user's phone to the server in a message of text or as a DTMF (Dual-Tone Multi- Frequency) tone. Subsequently, the server calls the destination number and, when the call is answered, connects the two lines. In this embodiment, the steps of using a phone may be, from the user's point of view, the same as in to using a conventional phone, and the mechanism of connecting the lines is hidden from the user. (Emphasis added.)

Kuwabara does not disclose any gateway or server receiving a message or call. Instead, it clearly teaches dialing the called party's telephone number, using the IP phone connected to the PC. The

ringing tone is fake in the sense that it needs to be generated by the IP phone in order for a user to hear something. This is because Internet dialing is normally silent. However, the ringing tone is generated as a result of directly dialing a destination telephone. This is clearly different from activating a ring tone when a gateway is receiving a message, as claimed in the present application.

Messaging a gateway or calling a server are completely different functions compared to dialing the destination number of a called party. Applicants submit that a skilled person would not readily substitute one for the other because dialing the destination number (as taught in Kuwabara) would directly negate the purpose of the present invention, which is precisely to avoid directly dialing of the destination number in order to avoid incurring roaming charges.

In view of the amendment and remarks, independent claims 1, 19, 37 and 42 are seen to clearly and patentably distinguish over the cited art. The other claims all depend directly or indirectly from claims 1, 19 and 37 and are allowable for at least the same reasons.

CONCLUSION

In view of the amendment remarks, reconsideration of the application is respectfully requested. After the amendment, claims 1-17, 19-35 and 37-42 are still pending and a Notice of Allowance for these claims is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact the Applicants' representative at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

Respectfully submitted,

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